REMARKS

This responds to the Office Action dated June 15, 2006 and Advisory Action dated August 29, 2006 and is filed subsequent to the Notice of Appeal mailed by Applicant on December 15, 2006.

Claims 1, 14, and 15 are amended, claims 14, 15, and 25-96 are cancelled, and no claims are added; as a result, claims 1-13 and 16-24 remain pending in this application.

§103 Rejection of the Claims

Claims 1-13, 15-61 and 63-96 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson et al. (U.S. Patent No. 6,549,894) and Schneider (U.S. Patent No. 5,987,464).

To form a proper rejection under 35 U.S.C. §103, the reference (or references when combined) must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Here, Simpson describes a legal matter docketing system in which a database stores data related to actions to be taken with respect to the legal matters, as well as dates associated with the actions. Simpson fails to describe a security module as is recited in the pending claims, or to incorporate other features of the pending claims such as managing such data via the Internet or restricting Internet access to such data.

The Schneider reference describes a system in which the amount of data to be sent as part of a subscription service via an online transmission, such as patent status, is minimized by use of update data files that are indexed along with previously existing data, such as may be distributed by compact disc or other media to a subscriber. The patent status records do not have an expiry time, but are time sensitive in that it is desired that a subscriber's patent database of public patent status information be up-to-date. More specifically, these issued patent status update records do not reflect pending legal matters such as patent applications and do not have associated due dates or tasks. Further, they are not accessed via the Internet, but are installed on a local subscriber machine and indexed before a subscriber is able to use the new data (*see, e.g.,* col. 5, ln. 6-9 and surrounding text).

In contrast, the claims of the present invention describe a system in which access to task and matter data is made available via the Internet, where access is managed via a security module operable to restrict Internet access to such data. Neither Simpson nor Schneider describe Internet-based management of data at all, as Simpson is entirely silent on such features and Schneider discusses only receiving updates for a subscription via a network and does not contemplate actual access or management of the data via the Internet as is recited in the pending claims.

Further, neither reference discusses a security module operable to restrict the ability of an Internet user to manage such data over a network. Simpson discusses in the cited col. 5, ln. 28-48 that operation of a program running on a single local computer can be restricted via a user verification screen such as that of Fig. 2, but use of security functions to *"restrict Internet access to patent application task and matter data management to selected system users"* as is recited in the pending claims, or to restrict any network access of any kind, is not discussed and has not been shown to be present in either reference during prosecution.

In forming a rejection under 35 U.S.C. §103, the Examiner has the burden to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

> Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

> In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

There must therefore be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Should references showing each element of the pending claims be found at some point in prosecution, motivation for combination of the references can't be taken from official notice or hindsight, but must be present in the references themselves. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Here, no motivation for combination of the Simpson and Schneider references has been shown, and such combination is simply an improper piecemeal rearrangement of parts from separate references. Piecemeal reassembly of parts from cited references to achieve a structure or function not contemplated by either reference is improper, and the fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Because management of data such as matter and task data via the Internet is not contemplated in either reference, because no security module operable to restrict the ability to manage such data via the Internet is found in either reference, and because no motivation for combination of the references is found in the references themselves, applicant believes the pending claims are in condition for allowance.

Nevertheless, Applicant has chosen to reduce the number of pending claims and amend the remaining independent claim 1 to simplify the examination and prosecution process. Applicant reserves the right to pursue the cancelled claims at a later date. The amended independent claim 1, from which all of the remaining claims depend, directly or indirectly, is further patentable because the cited references fail to provide any teaching regarding "a messaging module operable to provide messaging to users of the system, wherein the messaging comprises automated messages to particular users, the messages relating to matters and tasks associated with the particular users and stored in a manner searchable and retrievable by matter."

Thus, applicant respectfully submits that the pending claims are patentable over the cited references. Reexamination and allowance of the claims is therefore respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6976 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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